Attorney Docket No. UV-48

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Michael D. Ellis
Application No.	:	09/262,870 Confirmation No. : 1124
Filed	:	March 4, 1999
For	:	PROGRAM GUIDE SYSTEM WITH VIDEO-ON-DEMAND BROWSING
Group Art Unit	:	2623
Examiner	:	Hunter B. Lonsberry

Palo Alto, CA 94301
May 4, 2007

Mail Stop: AF
Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Pursuant to 1296 Off. Gaz. 2 (July 12, 2005), applicant requests review of the final rejection of claims 1-13, 15, 16, 18, 50-59, 62-66, 98-107, 110-114 and 146-157 in the above-identified application. No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal.

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ARGUMENTS

I. Summary of the Office Action

Claims 1-4, 6-13, 15, 18, 50, 52, 54-59, 62-65, 98-107, 111, 112 and 146-157 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over LaJoie (U.S. Patent 5,850,218) in view of Walter (U.S. Patent 4,506,387). Claims 16, 51, 110, 113 and 114 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over LaJoie in view of Walter and several allegedly well-known program guide features. Claims 5 and 53 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over LaJoie in view of Walter in further view of Dunn (U.S. Patent 6,571,390). Claim 66 was finally rejected under 35 U.S.C. § 103(a) as being unpatentable over LaJoie in view of Walter in further view of Yates (U.S. Patent 6,330,586).

II. Summary of Arguments

For the purposes of this Request, applicant will show that (1) the Examiner has made a clear error by asserting that an essential element of applicant's claims is inherently disclosed in the cited references, and (2) the alleged combination of the cited references, which were used to reject independent claims 1, 50, 98 and 146-148 under 35 U.S.C. § 103(a), omits at least certain essential elements required to establish a *prima facie* rejection of these claims. Applicant reserves the right to present additional arguments upon the decision of the panel review.

III. Examiner's Assertion That VOD Program Listings Are Inherently Disclosed Is a Clear Error

Applicant submits that the alleged combination of LaJoie and Walter used to reject independent claims 1, 50, 98 and 146-148 under 35 U.S.C. § 103(a) fails to show or suggest each limitation of the claims at least because none of the references teaches displaying "a partial screen program guide display" that includes "at least one video-on-demand program listing."

In particular, LaJoie does not show a partial screen program guide display that expressly includes at least one VOD program listing that is available for immediate display to the viewer. The displays cited by the Examiner refer only to pay-per-view (PPV) programming (see, *e.g.*, LaJoie at FIGS. 25 and 29) or broadcast programming. The Examiner concedes this lack of express disclosure by contending that LaJoie "inherently includes means for displaying VOD program listings." (Office Action at pages 5 and 10; emphasis added.)

Applicant submits that the mere reference to a "VOD service" in LaJoie is insufficient to support the contention that VOD program listings are inherently disclosed in LaJoie. Indeed, applicant respectfully submits that the Examiner has made a clear error by not providing the requisite "rationale or evidence tending to show inherency" of VOD program listings in LaJoie. (MPEP § 2112.) Specifically, it has not been established that VOD listings are "necessarily present in the thing described in the reference, and that it would be recognized by persons of ordinary skill." (MPEP § 2112, citing *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); emphasis added.)

Not only are VOD program listing not inherently disclosed in LaJoie, applicant submits that LaJoie teaches away from any such inherent disclosure. VOD programming is different than either broadcast or pay-per-view (PPV) programming. VOD programs "consist of a library or database or programs that are available at any time for viewing," and thus viewers may "watch the [VOD] programs contained in the database at virtually any time." (Specification at page 2, lines 5-7, 14-16.) As a result, VOD programs can be selected or ordered by the viewer without regard to start time or channel, and are available for immediate display to the viewer. In contrast, both broadcast and PPV programming are associated with specific start times and channels, both of which are pre-scheduled.

Applicant submits that LaJoie neither discloses nor suggests how its PPV or broadcast program guide displays could be used or modified for ordering VOD programs or selecting VOD program listings. As a result, partial screen program guide displays with VOD program listings in the manner of applicant's claimed invention could not be "necessarily present" in LaJoie.

For at least these reasons, applicant submits that the Examiner's contention that VOD program listings are inherently disclosed in LaJoie is unsupported and, indeed, LaJoie teaches away from such a feature. Therefore, applicant submits that the Examiner's assertion that this feature is inherently disclosed in LaJoie is clearly erroneous.

Moreover, because the cited references do not disclose this feature of independent claims 1, 50, 98 and 146-148, it is apparent that the Examiner's rejection of these claims under 35 U.S.C. § 103(a) was made despite omitting this essential element. As a result of this omission, a *prima facie* case of the unpatentability of claims 1, 50, 98 and 146-148 under 35 U.S.C. § 103(a) was not established. For at least this reason, claims 1, 50, 98 and 146-148 are patentable over LaJoie and Walker.

IV. References Do Not Disclose Allowing A Viewer To Select A VOD Program Listing

As discussed above, the cited references fail to disclose, either expressly or inherently, displaying a partial screen program guide that includes at least one VOD program listing. Therefore, for at least this reason, applicant submits that the cited references also fail to disclose "allowing a viewer to select at least one of the video-on-demand program listings," which is a feature of independent claims 1, 50 and 98.

Therefore, applicant submits that the rejection of claims 1, 50 and 98 under 35 U.S.C. § 103(a) omitted also this essential element and, as a result, a *prima facie* case of unpatentability of these claims under 35 U.S.C. § 103(a) was not established. For at least this additional reason, claims 1, 50 and 98 are patentable over LaJoie and Walker.

V. References Do Not Disclose Allowing A Viewer To Order A VOD Program Listing

As discussed above, the cited references fail to disclose, either expressly or inherently, displaying a partial screen program guide that includes at least one VOD program listing. Therefore, for at least this reason, applicant submits that the cited references also fail to

disclose "allowing a viewer to order a video-on-demand program associated with at least one video-on-demand program listing," which is a feature of independent claims 146-148.

Therefore, applicant submits that the rejection of claims 146-148 under 35 U.S.C. § 103(a) omitted also this essential element and, as a result, a *prima facie* case of unpatentability of these claims under 35 U.S.C. § 103(a) was not established. For at least this additional reason, claims 1146-148 are patentable over LaJoie and Walker.

CONCLUSION

The foregoing demonstrates that claims 1, 50, 98 and 146-148 are allowable over the prior art of record. Dependent claims 2-13, 15, 16, 18, 51-59, 62-66, 99-107, 110-114 and 149-157, which contain all of the features of claims 1, 50, 98, 146, 147 or 148, are allowable for at least the same reasons. Reconsideration and allowance of the application is respectfully requested

Respectfully submitted,

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